November 25, 1996

VIA FACSIMILE
CONFIRMATION BY MAIL

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Re: PTO Proposed Rule Making Published in 81 Fed. Reg. On September 23, 1996

Dear Rene:

I hope that this partial response to your letter of October 4, 1996, can still be considered as you formulate a presentation to the AIPLA Board. I simply have not found the time to wade through the entire set of proposed rule revisions, but I will attempt to do so in the next few days and provide any other input that might be helpful in your presentations now or later.

I am in favor of Resolution 1 of your draft, i.e. in both instances of the "Favors/Opposes" points.

Further, I recommend that the Patent and Trademark Office be urged to express in their written Rule 1.137 all of the basic interpretations and guidelines (presumptions) by which they "read" and apply the stated Rule. A good example is their three month rule of diligence as applied to unintentionality and/or unavoidability of "delay" as referred to in the PTO's discussion which accompanies the proposed changes in and applications of the Rule. If that is a parameter that they apply, it should be so stated in the Rule to put applicant's on notice.

Another illustration is the fact that Rule 1.137, and particularly 1.137(b) does not distinguish between the ultimate fact or legal conclusion of "abandonment" and applicant's activity or lack thereof as "delay". Abandonment may be unintentional though caused by deliberate inactivity on behalf of the applicant. "Delay" might refer to a "delay" that caused the abandonment as well as referring to a post-abandonment lack of diligence in seeking restoration. A simple and not unusual fact situation is illustrative. Assume an applicant believes that a response to a "FINAL" Office Action has placed his or her application in condition for allowance, with or without an oral understanding with the Examiner. Applicant believes the case is allowable and will be allowed. Therefore, applicant deliberately takes no further steps to safeguard pendency as the statutory "Final" date passes, in the sincere belief that the expenditure of additional funds for a Notice of Appeal and perhaps a related extension of time fee is unnecessary and unjustified. But something intervenes, for example the applicant is in error, or there is a change of mind by the Examiner or a review by another authority such as a holding that an Examiner's initial stated acceptability of a Terminal Disclaimer is erroneous. The PTO then holds that the application is abandoned for failure to fully respond to the Office Action. The inactivity or "delay" of applicant in not taking saving action during this time span, until learning of the holding of abandonment, was not "unintentional" in a literal sense.

In any event, there clearly are at least two distant issues in each abandonment and petition to revise situation; namely: whether the applicant intended to abandon the application and whether applicant acted diligently (without undue delay) after learning of the holding of abandonment. This distinction between the status of the application and remedial activity on behalf of applicant is recognized in the PTO's discussion of Rule 1.137. Unfortunately, the language of the Rule does not make the distinction.

In fact, prior to 1993, Rule 1.137 was, I believe, written entirely in terms of the ultimate fact of unintentiality of the abandonment. However, the PTO also was inferring, or sought to apply, the rule to require diligent remediation. The PTO intended to reflect this diligence parameter in the 1993 change to Rule 1.137. However, the changed language speaks only of "delay". This then required the Office to infer the issue of intentionality/unintentionality of the abandonment within the "delay" term. It seems logical and highly desirable for clarity of communication that the Rule explicitly address both aspects. The Rule should explicitly express all interpretations or parameters that the Office routinely applies.

Rule 1.10

It is disappointing that the current rather massive reworking of the Rules makes only an editorial change in Rule 1.10. It does not address the basic issues regarding the application of Rule 1.10 that were recognized at least in part by the proposals published under date of October 26, 1995; see 1180 OG 122-126, November 28, 1996. As you may recall, I believe there are even greater problems with that Rule with respect to distinctions between what the Rule states literally and the interpretation routinely applied by the PTO. Specifically, while Rule 1.10 requires that an applicant generate and submit various items of evidence concerning the date on which the "Express Mail" was mailed, the PTO's interpretation and standard application of that Rule is that the phrase "a copy of the 'Express Mail' receipt showing the actual date of mailing and a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified", in subsection (C), conveys the meaning that the date entered on the Express Mail receipt by a postal clerk is the *sine qua non* for determining the filing date, it controls over all other evidence as to when that Express Mail was mailed/deposited by the applicant. See again my comments of December 29, 1995 and January 2, 1996 to the PTO in that regard, and which you kindly presented to the committee during the APIA Mid-Winter Meeting. Copies are attached for your convenience.

Thank you for your consideration.

Yours very truly,

LEYDIG, VOIT & MAYER, LTD.

By: _____
Noel I. Smith

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